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Robert S. Stewart

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EXAMINER

APPLE, KIRSTEN SACHWITZ

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/915,993	Applicant(s) STEWART ET AL.	
	Examiner KIRSTEN S. APPLE	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the Remarks response filed on 5/28/2008

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Examiner finds these method claims lack structure such as on a "computer readable medium". One example of corrective action might be to place "electronically" before an action verb and "on computer (or other appropriate structure)."

For example in the claim:

“Method comprising:

Calculating a score

Assigning rank...”

Would need to become:

“Method comprising:

Electronically calculating a score on a processor...

Electronically assigning rank on a processor...”

This is just one elementary example to provide guidance however there may be various ways to overcome the 101 method without structure rejection.

Claim Rejections - 35 USC § 102

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claims 1-34 under 35 USC 102.

The Applicant attention is re-drawn to the following:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Luskin (US Patent 6,564,191 B1).

Re claim 1 & 7 & 22: Luskin discloses:

An investment management system & method & computer readable medium (see Luskin, title), comprising:

Receiving a request from a user (see Luskin, Figure 6, Item 700)

Performing the operation on the portfolio (see Luskin, Figure 6, Item 900)

An application server (see Luskin, Figure 3, Item 102), to perform => following:

Portfolio analysis of an investment portfolio (see Luskin, Figure 6, Item 900)
portfolio analysis includes aggregating a plurality of securities in the investment portfolio by security type (Luskin, abstract, “plurality of assets” a portfolio by definition is a “portfolio of assets or securities” meaning more than one – in the current form any invention using portfolio would read on this limitation)

Portfolio monitoring of the investment portfolio (see Luskin, Figure 6, Item 900)

Reporting at least one holding of the investment portfolio (see Luskin, Figure 6, item 906)

A database server in communication with the application server (see Luskin, Figure 3, item 108)

Re claim 2: Luskin discloses:

Web browser in communication with application server (see Luskin, Figure 3, item 130 a browser is a specific type of display)

Re claim 3: Luskin discloses:

User = investment profession (see Luskin, column 4, line 1-69 specifically 30-32)

customer = investment professional (see Luskin, column 4, line 1-69 specifically 30-32)

Re claim 4: Luskin discloses:

Database server =>

User database (see Luskin, Figure 3, Item 112)

Account database (see Luskin, Figure 3, Item 112)

Portfolio database (see Luskin, Figure 3, Item 110)

Company/security database (see Luskin, Figure 3, Item 114)

Publication database (see Luskin, Figure 3, Item 114)

Re claim 5: Luskin discloses:

Application server performs =>:

Track the performance (see Luskin, Figure 6, Item 906)

Record an investment policy (see Luskin, Figure 5, Item 704, 706 & 710)

Optimization of a plurality of investment portfolio (see Luskin, Figure 6, Item 900)

Perform base currency translation (see Luskin, abstract "currency" is an example of an asset)

Enable block trades (see Luskin, Figure 6, Item 904)

Track relationships among customers (see Luskin, Figure 6, Item 906)

Because the claim language stated "at least one" (=>) only one item needs to be referenced in the prior art in order to deny the claim.

Re claim 6: Luskin discloses:

Application server performs an operation on a periodic basis upon request by user (see Luskin, figure 6, item 902)

Re claim 8: Luskin discloses:

Authentication the user (see Luskin, Figure 8, Item 701)

The examiner claims that it is inherent to verify (authentication) a user before they start

Re claim 9: Luskin discloses:

Updating data in a database (see Luskin, Figure 5, item 904)

Re claim 10: Luskin discloses:

Receiving a request = to perform an operation on the portfolio on a scheduled basis (see Luskin, Figure 6, item 902)

Re claim 11: Luskin discloses:

Operation is selected from the group additionally consisting of responding to an account inquiry (see Luskin, Figure 7, Item 703 it is inherent this based on an inquiry)

Re claim 12: Luskin discloses:

Operation is selected from the group additionally consisting of responding to an asset inquiry (see Luskin, Figure 7, Item 703 it is inherent this based on an inquiry)

Re claim 13: Luskin discloses:

Operation is selected from the group additionally consisting of responding to an investment policy (see Luskin, Figure 7, Item 703 “investment strategy”)

Re claim 14: Luskin discloses:

Operation is selected from the group additionally consisting of comparing at least one holding of the portfolio to a predefined criterion (see Luskin, Figure 6, item 710 “investment horizon” is a example of predefined criterion)

Re claim 15: Luskin discloses:

Operation is selected from the group additionally consisting of comparing at least one holding of the portfolio to a target allocation (see Luskin, Figure 6, item 710 “contribution data” is an example of target allocation - defined by user)

Re claim 16: Luskin discloses:

Operation is selected from the group additionally consisting of performing an optimization calculation on at least on holding of the portfolio (see Luskin, Figure 6, Item 900)

Re claim 17: Luskin discloses:

Operation is selected from the group additionally consisting of publishing a document and searching a document (see Luskin, Figure 6, Item 902)

Re claim 18: Luskin discloses:

Operation is selected from the group additionally consisting of performing relationship tracking for a plurality of customers of an investment professional (see Luskin, Figure 6, Item 906)

Re claim 19: Luskin discloses:

Operation additionally includes tracking a performance of at least one holding of the portfolio (see Luskin, Figure 6, Item 906)

Re claim 20: Luskin discloses:

Operation is selected from the group additionally consisting of a currency translation (see Luskin, abstract "currency" is an example of an asset)

Re claim 21: Luskin discloses:

Operation is selected from the group additionally consisting of trading a block of holdings of the portfolio (see Luskin, Figure 6, Item 902)

Re claim 23: Luskin discloses:

Computer readable medium having stored thereon additional instructions which, when executed by the processor, cause the processor to authenticate the user (see Luskin, Figure 3)

Re claim 24, 27 & 30: Luskin discloses:

Scenario analysis (see Luskin, Paragraph 25) scenario analysis includes an analysis of possible trades of at least one security (see Luskin, Figure 6, item 900)

Re claim 25, 28 & 31: Luskin discloses:

Linking at least one publication to at least one holding of the investment portfolio (see Luskin, column 11, line 37-51)

Re claim 26, 29 & 33: Luskin discloses:

Trade calculation and rebalancing (see Luskin, Figure 6, item 902 & 904)

Response to Arguments

Applicant's arguments filed 5/28/08 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1st: claim 1 “at least the following” includes all of the limitation.

As can be seen in the rejection above all of the limitations in claim 1 have been address in this office action.

Applicants argued 2nd, with filed Declaaration Reddy is no longer valid

This argument is mute in view of the above office action citing Luskin.

Applicants argued 3rd, declaration of unexpected result...

The Examiner has read all of the declarations submitted with the case. The Examiner believes the applicants have developed an excellent product which has been selling in the marketplace – the company should be proud of this accomplishment. However, the examiner does not see the novelty in the claims. Right now the claims read on not only Luskin but most all of the art in the financial portfolio analysis area.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

/Kirsten S Apple/

Primary Examiner, Art Unit 3694